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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,025	08/07/2001	Lynne Biggar	40655.4200	3016

7590 03/26/2004

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EXAMINER	
LABAZE, EDWYN	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/924,025	BIGGAR ET AL.	
	Examiner	Art Unit	
	EDWYN LABAZE	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 12/29/2003.

2. This application claims the benefit of U.S. Provisional Patent Application number 60/272,487 filed on 2/27/2001.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-43, and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (U.S. 6,270,012) in view of Moro (U.S. 6,363,351).

Re claims 1, 3, 5-7, 11-12, 16-17, 23, 27, 30, 35-36, 41, and 44-46: Dawson teaches debit card with activation control, which includes means for activating a debit card 100 sold to a consumer inactivated for security purposes (col.6, lines 27-51); a data terminal 402 [which may be a personal computer and also include alternative input means such as a bar code reader or the like] for providing the consumer to input predetermined card information, and authentication [to verify if the card is genuine; col.6, lines 35+] and service data, when available, to the site and communicating the predetermined card information to the second computing system 405 over the first network (as shown in fig.# 4 of Dawson; col.6, lines 1+); means for generating by the host computer 405 processing results (col.); and notifying the consumer of the results [by transmitting an appropriate message to the data terminal 402] (col.6, lines 55-60); wherein the authentication and service data includes information [such as the card identification number 102,

which includes the information of the consumer wherein the card is to be shipped; and the PIN 101]in addition to and different from information identifying the consumer (see fig. # 1 of Dawson; col.5, lines 10+).

Dawson is silent with regards with the internet/on-line use, means of prompting a notice to the consumer to access the site so as to activate the card, and a personal computer as a data terminal.

Moro discloses subscriber registration and access control system and related methods, which includes means of activating a non-activated card by providing requisite personal and billing information to a processing center 18 by a direct telephone, the internet or fax (col.6, lines 10-55). Moro further teaches that the notice corresponds to a new card, renewal card or a reissued/renewal card (col.8, lines 55-67); means of utilizing return e-mail for transmitting activation results (col.6, lines 10-32). Moro further discloses the activation of token 38 [also known as a transponder; as in claim 44 of the claimed invention] (col.5, lines 47+).

In view of Moro's teachings, it would have been to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Dawson a personal computer as a data terminal and internet/on-line access so to permit the customer to activate the card using the internet as a network. Furthermore, such modification would provide personal comfort to the consumer [whether the data terminal is a personal computer; a laptop; a personal digital assistant/PDA or any other means of accessing the internet] without deliberate activation at a retail establishment and permit access to other provided benefits/services offered by the card issued company/provider. Moreover, such modification would have been an obvious extension as taught by Dawson, therefore an obvious expedient.

Re claims 2, 18: Dawson teaches a system and method, further comprising the step of providing at least a third computer system in communication with the second computer system over a second network (see fig. # 4 of Dawson).

Re claim 4: Dawson discloses a system and method, wherein the first network and the second network being configured to transmit data by a transmission means, the transmission means selected from the group consisting of wire transmission [such as PSTN/public switched telephone network 404 as discloses in fig. # 4 of Dawson], wireless transmission, satellite transmission, radio frequency transmission, cable transmission, digital signal subscriber transmission and fiber optic transmission (col.6, lines 10+).

Re claims 8, 13, 25, 37, and 47: Dawson as modified by Moro fails to disclose means to present to the consumer the option of manually calling the provider and the option of interactively communicating with the provider on the first computing system if the card cannot be activated on-line for any predetermined reason.

However, since the activation could be either through a telephone call, fax, or the like; it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the system of Dawson as modified by Moro a subroutine in the operating software prompting a message alerting the consumer of the activation decline and the option of calling the center/provider. Furthermore, such modification would be beneficial to the consumer and presents an alternative means to activate a card in the event the on-line system is down/non-operative. Moreover, such modification would have been an obvious of the teaching of Dawson as modified as Moro.

Re claims 9, 14, 21, 38, and 48: Dawson teaches a system and method, further comprising the step of processing the predetermined card information by fraud rule (col.6, lines 21-41).

Re claims 10, 15, 22, 26, 39: Dawson teaches a system and method, comprising the step of allowing the second computing system to determine whether the consumer is a member of an existing provider service by prompting the consumer to submit service identification data to the second computing system allowing the second computing system to validate the service identification data and authenticate the existing provider service if the consumer's membership is valid, and notifying the consumer on the first computing network of the second computing system's provider service authentication results (col.6, lines 30-60).

Re claim 19 and 28: Dawson discloses a system and method, wherein the results further being generated by the second computing system 405 by processing the predetermined card information against stored account data in order to activate the card (col.6, lines 42+).

Re claims 20 and 29: Dawson teaches a system and method, further comprising the step of allowing the second computing system 405 to generate online card activation decline message to the cardholder on the first computing system 402 if the card cannot be activated (col.6, lines 57+).

Re claims 24 and 40: Dawson as modified by Moro discloses system and method, further receiving from the computer system a consumer's name and account number and account identification number [including identification numbers 102, 102' and PIN number 101] as part of the predetermined device information, the web [as modified by the teachings of Moro] site further storing the device information and processing the device information for activation,

fraudulent entries, erroneous entries, and further performing validation processing on consumer supplied data and performing dynamic authentication [by performing tests to verify if the card is genuine] processing on consumer supplied data (col.5, lines 45-67; col.6, lines 1-60).

Re claim 42: Dawson discloses a system and method, wherein the device is a financial instrument [such a debit card 401 as shown in fig. 4 of Dawson] (col.5, lines 63+).

Re claims 31-34: the teachings of Dawson as modified by Moro have been discussed above. Dawson as modified by Moro fails means to allowing the second computing system to generate a card already activated message to the cardholder or the first computing system if the card is determined by the second computing system to have already been activated.

However, since the second computing system is required to generate and transmit an appropriate message to the first computing system regarding the refusal and/or acceptance of the card activation, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the system of Dawson as modified by Moro a subroutine in the operating software prompting a message alerting the consumer that the card has already been activated. Furthermore, such modification would be beneficial to the consumer and provide a green light for usage of the card for financial transaction over the Internet. Moreover, such modification would have been an obvious of the teaching of Dawson as modified as Moro.

5. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (U.S. 6,270,012) as modified by Moro (U.S. 6,363,351) above in claim1, and further in view of Laursen et al. (U.S. 6,233,608).

The teachings of Dawson as modified by Moro have been discussed above.

Dawson as modified by Moro fails to teach means of activating a cellular phone.

Laursen et al. discloses method and system for securely interacting with managed data from multiple devices, which includes means of activating a cellular phone 106 over the Internet (col.7, lines 50-67).

In view of Laursen et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the system of Dawson as modified by Moro the activation process of a cellular phone so provide to the consumer the benefits of activating the cellular phone using the internet as a network. Furthermore, such modification would provide personal comfort to the consumer without deliberate activation at a retail establishment and permit access to other provided benefits/services offered by the cellular phone issued company/provider. Moreover, such modification would have been an obvious extension as taught by Dawson, therefore an obvious expedient.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zolotarev et al. (U.S. 6,557,759) discloses method enabling a purchaser to ask for the execution of an obligation related to a card and enabling an emitter to recognize said obligation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
March 17, 2004

KARL D. FRECH
PRIMARY EXAMINER